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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/10/94-0077 10/94-00 VALKANNAS

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EXAMINER

CINTINS, I

ART UNIT

PAPER NUMBER

1724

DATE MAILED:

06/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/205,297

Applicant(s)

Valkanas et al.

Examiner

Ivars C. Cintins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 28, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-47 is/are pending in the application.
- 4a) Of the above, claim(s) 29-31 and 34-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27, 28, 32, and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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Acknowledgment is made of Applicant's election of: (1) **SEBS** as the polymer species; and (2) **dichloroethane** as the chlorinated solvent species. Accordingly, claims 27, 28, 32 and 33 are deemed to read on the elected species; claims 36-47 are withdrawn from further consideration, as being directed to non-elected inventions; and claims 29-31, 34 and 35 are withdrawn from further consideration, as being directed to non-elected species.

The amendment filed March 30, 2000 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. Applicant's replacement of the term "macroplegmatic" with the term "macroreticular" throughout the specification (e.g. page 2, lines 10 and 28; and page 3, lines 4, 8 and 12) does not appear to be supported by the disclosure originally filed, and hence constitutes **new matter**. Applicant is required to cancel the new matter in the reply to this Office action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 27, 28, 32 and 33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The limitation that the recited product is "macroreticular" (claim 27, line 1) does not appear to be supported by the disclosure originally filed, and hence constitutes **new matter**.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28, 32 and 33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The term "ethylene and butadiene SEBS" (claim 28, lines 2-3) is vague, and indefinite as to the limitation intended. If Applicant is attempting to recite ethylene in combination with butadiene as one polymer species, and SEBS as another polymer species, then a comma should be inserted between "butadiene" and "SEBS" in the above noted

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expression. Claim 32 is indefinite because it recites that the chlorinated solvent is dichloroethane, but depends from claim 30 which claim appears to exclude this solvent material, i.e. by reciting that the chlorinated solvent is 1,4-dichloromethyl-2,5-dimethylbenzene and TiCl_4 . Claim 33 is indefinite because it is not clear what is meant by the term "the product has Mc of 50,000."

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 27 and 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Meitzner et al (U.S. Patent No. 4,297,220). The reference discloses a macroreticular (col. 5, lines 31, 39-40 and 49) crosslinked polystyrene polymer (col. 8, line 5), which polymer has an affinity for organic solvents (col. 9, line 53); and this is all that is required by claims 27 and 28.

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Claims 27 and 28 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Vulliez-Sermet et al (U.S. Patent No. 3,979,287). The reference discloses a macroreticular (col. 3, line 16) crosslinked (col. 2, line 44) polymer of the type recited (col. 3, lines 25-26 and 31), which polymer has an affinity for organic solvents (col. 1, line 62); and this is all that is required by claims 27 and 28.

Claims 27, 28 and 32 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rosenbaum (U.S. Patent No. 5,460,792). The reference discloses a macroreticular crosslinked polystyrene polymer (col. 4, lines 63-64), which polymer has an affinity for dichloroethane (col. 6, line 7); and this is all that is required by claims 27, 28 and 32.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meitzner et al, Vulliez-Sermet et al, or Rosenbaum. Each of the references discloses the claimed

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invention with the exception of the recited "Mc" value. However, the exact "Mc" value of the polymer employed is not seen to materially affect its overall properties, or to produce any new and unexpected result; and is therefore deemed to be an obvious matter of choice, insufficient to patentably distinguish this claim.

Schwarz et al (U.S. Patent No. 5,017,436) discloses (col. 2, lines 20 and 41-42) that SEBS is a well known material.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the

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statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Friday from 9:30 AM to 6:00 PM.

The fax phone numbers for this art unit are: (703) 305-3599 for "Official" faxes after Final Rejection; (703) 305-7718 for all other "Official" faxes; and (703) 305-3602 for "Draft" and other "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Ivars Cintins
Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
June 17, 2001